



REPLY BRIEF
U.S. Application No. 09/520,763
Attorney Docket No.: 53326.000008

AF/3628
123
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Patent Application of :)
Stephen W. COMISKEY *et al*) Group Art Unit: 3628
Serial No.: 09/520,763) Examiner: Debra F. Charles
Filed: March 8, 2000) Confirmation No. 1661
For: SYSTEM AND METHOD FOR PROVIDING FINANCIAL SERVICES TO
HIGH NET WORTH INDIVIDUALS

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REPLY BRIEF

Sir:

This is Appellants' Reply Brief (submitted in triplicate) responsive to the Examiner's Answer mailed April 26, 2004, in connection with the above-captioned patent application. Appellants present this brief to clarify points raised by the Examiner in the Examiner's Answer. Appellants believe that there is no fee required for the submission of this Reply Brief. However, the Commissioner is hereby authorized to charge Deposit Account No. 50-0206, if deemed necessary.

I. The Examiner's Proposed Combination Fails to Show Each and Every Claim Limitation

The Examiner's combination of Moran, McGovern *et al* and VIP Forum completely fails to render the claimed inventions obvious. The Office Action admits the major deficiencies of the primary reference, Moran (page 5, Office Action mailed September 16, 2003). Moran fails to

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disclose at least five elements out of the seven major elements of independent claims 58 and 66.

The Office Action relies upon McGovern *et al* and VIP forum to address the major deficiencies.

The Examiner's Answer alleges that McGovern *et al* solves the same problem by effectively ranking employees by their desirability to the customer (page 9, Examiner's Answer mailed April 26, 2004). In justifying the proposed combination of Moran, McGovern *et al* and VIP Forum, the Examiner summarily concludes that

“the list of the services provided needed not be explicitly mirrored in each reference or in the combination of references to convey the same concept and solve the same problem of providing specialized services based on specific needs identified. Thus, the prima facie case of obviousness is demonstrated.” (page 11, Examiner's Answer mailed April 26, 2004).

Based on Examiner's allegation that the combination of references conveys the same concept and solves the same problem, the Examiner concludes that obviousness is demonstrated. This reasoning is seriously flawed and, at best, confusing. Obviousness is not based on whether a combination of references conveys the same concept and solves the same problem. For a proper rejection under 35 U.S.C. § 103, three basic criteria must be met, as outlined in MPEP 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference(or references when combined) must teach or suggest ***all the claim limitations***. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. Examiner's allegation that the combination of references conveys the same concept and solves

the same problem does not satisfy the requirement that the references must teach all the claim limitations.

In addition, Appellants disagree that the combination of Moran, McGovern *et al* and VIP forum convey the same concept and solve the same problem as Applicants' claimed inventions. Moran appears to be directed to financial planning and advice. McGovern *et al* appears to provide a search functionality within a repository of candidates according to specified selection criteria. VIP Forum appears to provide a listing of services provided by different banks. It is unclear as to what same problem is solved by these three disparate references. Further, it is even more unclear as to how this alleged same problem is met by Appellants' claimed inventions.

The combination of claim limitations as recited by Appellants are clearly not met by the combination of Moran, McGovern *et al* and VIP Forum. More specifically, the combination of references fails to address at least the limitations directed to “(c) *assigning a plurality of services to a plurality of service provider groups*, further comprising the steps of: (i) *determining whether each service is needed by the client on a frequent basis*; (ii) *determining whether a level of value to the client is above a predetermined level*; and (iii) *categorizing the plurality of services into a core service provider group, an affiliated service provider group and a non-affiliated service provider group, wherein the step of categorizing is based at least in part on the steps of determining wherein the steps of assessing and assigning are performed at a server*; and (d) *providing services in a hierarchical manner from the core service provider group, the affiliated service provider group and the non-affiliated service provider group in response to the received client data through a display*,” as recited in independent claim 58. Corresponding

limitations are recited in independent system claim 66. The Examiner has failed to provide a proper prima facie case of obviousness.

Regardless of whether the combination of references solves the same problem as Appellants' invention, it is well understood that two inventions may solve the same problem and yet contain patentably distinct limitations. It is the combination of claimed limitations that must be met by the references and not whether the same problem is being solved. Contrary to Examiner's understanding, solving the same problem does not render the claimed inventions unpatentable.

As for whether McGovern *et al* is non-analogous art, the statement of non-analogous art was first introduced by the Examiner. Page 4 of the Office Action mailed September 16, 2003 states "[t]hus, McGovern *et al* solves the same problem, *eventhough it is nonanalogous art.*" In response to Appellants mention of Examiner's statement in the Appeal Brief mailed March 19, 2004, the Examiner is now attempting to contradict Examiner's own statement of non-analogous art. McGovern *et al* has nothing to do with providing personalized financial services to a client. Rather, McGovern *et al* is directed to a training process to enable a service provider to anticipate and develop the service provider's personnel to meet business requirements and to provide timely availability of adequately trained personnel. (McGovern *et al*, col. 3, lines 24-34).

II. The Examiner's Proposed Combination is Fundamentally Flawed

Independent claims 58 and 66 are currently rejected under the Moran, McGovern *et al* and VIP Forum combination. The remaining dependent claims inherently contain the limitations of the corresponding independent claim. In the rejections concerning claims 58 and 66, the Examiner asserts that it would have been obvious to combine Moran, McGovern *et al* and VIP

Forum to obtain a cost-efficient way of providing referrals to various professionals and specialists (page 13, Examiner's Answer mailed April 26, 2004). The Examiner alleges that combining the references yield the end result of determining when the bank client needs the service and how frequently the service is needed (page 12, Examiner's Answer mailed April 26, 2004). However, the Examiner's Answer fails to identify what in the references teaches the proposed combination, other than improper hindsight and Appellants' own invention. What is fundamentally lacking in this analysis is any indication in any of the art that there is a problem that needs to be solved by combining these three references.

When a primary reference is missing elements, the law of obviousness requires that the Office set forth some motivation why one of ordinary skill in the art would have been motivated to modify the primary reference in the exact manner proposed. *Ruiz*, 234 F.3d at 664. In other words, there must be some recognition that the primary reference has a problem and that the proposed modification will solve that exact problem. All of this motivation must come from the teachings of the prior art to avoid impermissible hindsight looking back at the time of the invention. Because such a proper motivation to combine is missing, the combinations are improper and the rejections should be overturned.

If the approach taken by this Examiner were adopted, in almost every instance, some reason for a modifying a reference could be created by the Examiner unrelated to any actual problem recognized in the art. It is the requirement that the motivation to solve a recognized problem be from the teachings of the art that keeps the application process honest to the goal of avoiding hindsight reconstruction. Indeed, the very key aspect in determining obviousness

should be that there is a clear nexus between the teachings in the art as to the deficiencies in a particular way of doing things and a solution provided by the supplemental references.

If the Office were permitted to make such generalizations of art, almost every proposed combination could be supported by modifying a reference for the purpose of modifying the reference. Again, the absence of a teaching is the fundamental problem with the rejections proposed by the Examiner and the reason why these combinations are improper. Therefore, there must be some motivation to combine the elements besides for the sake of combining the references. In addition, even if the references could be combined as proposed by the Examiner, the resulting combination would nevertheless fail to render the claim inventions obvious.

III. The Examiner Has Failed To Meet The Burden Of Proof

Under U.S. law, an inventor is entitled to a patent for any invention that is new, useful, and non-obvious. 35 U.S.C. §101-103. The Answer has not presented a *prima facie* case of non-obviousness by which to deny a patent to Appellants. Rather than providing statements of motivation as taught by the references, the Examiner lists selective features without providing any reasoning as to why one of ordinary skill in the art would have been motivated to combine three disparate references. The Examiner summarily concludes that the claim limitations are met without ever explaining why one of ordinary skill in the art would (1) combine disparate references and (2) how the resulting combination meets the claimed inventions. Even if the references could be combined as suggested by the Examiner, the resulting combination would nevertheless fail to teach the combination of claim limitations recited by Appellants.

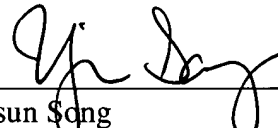
CONCLUSION

For at least the foregoing reasons, the rejections of claims 58-75 should be reversed.

Respectfully submitted,

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Dated: June 28, 2004



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REQUEST FOR ORAL HEARING

Sir:

Appellants respectfully request an Oral Hearing under 37 C.F.R. §1.194(b) for the above-captioned application. Pursuant to 37 C.F.R. §1.17(d), a check in the amount of \$165.00 is enclosed representing the Request for Oral Hearing filing fee.

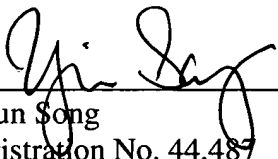
Appellants respectfully submits that no other fees are required in connection with this request. However, in the event it is determined that a further fee is necessary to maintain the

pendency of this application, the Commissioner is hereby authorized to charge or credit the undersigned's deposit account number 50-0206.

Respectfully submitted,

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